UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,092	11/02/2001	Joern Ostermann	2000-0600D	5335

83224   7590   06/26/2009
AT & T LEGAL DEPARTMENT - NDQ
ATTN: PATENT DOCKETING
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EXAMINER
PRENDERGAST, ROBERTA D

ART UNIT	PAPER NUMBER
2628	

MAIL DATE	DELIVERY MODE
06/26/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-48* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *43-48* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/21/2009 has been entered.

Claim Objections

Examiner acknowledges the amendment to claims 45-46, filed 4/27/2009, correcting the issues regarding the claim objection and therefore the objection to claims 45-46 is hereby withdrawn.

Claims 47-48 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 47-48 recite the limitation "wherein the text message is an email message", this limitation has been incorporated into the parent claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 43-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 43-48 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

In regard to 35 U.S.C. 101 and method/process claims - even though one or more steps may be associated with a respective system "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one.

Amended claims 43-44, line 4, recites "the method comprising performing at least one of the following steps via a processor:" this does not overcome the rejection

because it is not clear which step is being performed via a processor. Removing the

phrase "at least one of" would be sufficient to overcome this rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 43-44 and 46-48 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bickmore et al., U.S. Patent Application No. 2001/0019330 in

view of Delorie, "Why HTML Mail is Evil", downloaded from the internet, copyright

March 1999, pages 1-7.

Referring to claim 43, Bickmore et al. teaches a method of enabling a sender to

create a multi-media message to a recipient, the multi-media message comprising a

dialogue between at least two animated entities arranged to deliver respective portions

of a text message from the sender (Figs. 10-11 and 13), the method comprising:

presenting the sender with an option to choose at least two animated entities to

deliver respective portions of a text document to the, the choice of which animated

entity to deliver which portion of the text message being effected by the insertion in the

text message of a non-text indicator associated with the chosen animated entity

(paragraphs [0009]-[0011], [0052], [0059]-[0064], i.e. a user of a source computer

creates a computer animation by selecting a plurality of avatar ASL files, representing

an animated character, each character is linked to a portion of the text via an HTML tag

that specifies the avatar description file and an animation script file wherein the

animated character linked to that portion of the text document may perform animations

such as reading the portion of the text to which it is linked); and

delivering the multi-media message where the chosen animated entities deliver

respective portions of the text message according to a position in the text message of

the indicator associated with the animated entity (paragraphs [0009]-[0011], [0052],

[0059]-[0064], i.e. the computer avatar is encapsulated into an HTML file and

transmitted/delivered to the recipient/reader computer as text document, each

character/animated entity in document are heard to speak their portion of the text

document according to the position in the text document of the link associated with their

avatar definition file).

Bickmore et al. does not specifically teach wherein the text document is an e-mail

message document.

Delorie teaches this limitation (page 1, 3 and 5, lines 1-23, i.e. a sender writes an

e-mail text message based on underlying HTML commands such as those shown on

page 5).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method of Bickmore et al. to include the

teachings of Delorie wherein the user is able to enter text into an e-mail document such

that the message includes text that is modified and sent out as HTML (Delorie: page 1,

lines 1-3) and thus providing hypertext capabilities in electronic documents such that

animated characters can be commanded to execute an animation and/or speak a text

string (Bickmore et al.: paragraphs [0004]-[0005]).

Referring to claim 44, Bickmore et al. teaches a method of enabling a sender to

create a multi-media message to a recipient, the multi-media message comprising a

dialogue between at least two animated entities arranged to deliver respective portions

of a text message from the sender, the method comprising:

receiving from the sender a text message comprising an indicator of a first

animated entity and text associated with the first animated entity, and an indicator of a

second animated entity and text associated with the second animated entity

(paragraphs [0009]-[0011], [0052], [0059]-[0064], i.e. multiple computer avatars are

encapsulated into an HTML file and transmitted/delivered to the recipient/reader

computer as text document, each character/animated entity in document are heard to

speak their portion of the text document according to the position in the text document

of the link associated with their avatar definition file); and

delivering the multi-media message wherein the first animated entity delivers the

text associated with the first animated entity and wherein the second animated entity

delivers the text associated with the second animated entity, the delivering being

associated with an inserted, non-text indicator associated with a respective animated

entity for delivery of that portion of the document/message (paragraphs [0009]-[0011],

[0052], [0059]-[0064], i.e. multiple computer avatars are encapsulated into an HTML file

and transmitted/delivered to the recipient/reader computer as text document, each

character/animated entity in document are heard to speak their portion of the text

document according to the position in the text document of the link associated with their

avatar definition file).

Bickmore et al. does not specifically teach wherein the text document is an e-mail

message document.

Delorie teaches this limitation (page 1, 3 and 5, lines 1-23, i.e. a sender writes an

e-mail text message based on underlying HTML commands such as those shown on

page 5).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method of Bickmore et al. to include the

teachings of Delorie wherein the user is able to enter text into an e-mail document such

that the message includes text that is modified and sent out as HTML (Delorie: page 1,

lines 1-3) and thus providing hypertext capabilities in electronic documents such that

animated characters can be commanded to execute an animation and/or speak a text

string (Bickmore et al.: paragraphs [0004]-[0005]).

Referring to claim 46, the rationale for claim 44 is incorporated herein,

Bickmore et al., as modified above, teaches the method of enabling a sender to create a

multi-media message to a recipient of claim 44, further comprising:

providing the sender with options to control the position of each animated entity

chosen within the multi-media message (paragraphs [0009]-[0011], [0052]-[0053],

[0059]-[0064], i.e. the computer avatar is encapsulated into an HTML file and

transmitted/delivered to the recipient/reader computer as text document, each

character/animated entity in document are heard to speak their portion of the text

document according to the position in the text document of the link associated with their

avatar definition file, the position and poses of the avatar are defined in the animation

files, via specific avatar script commands, and included in the HTML <A HREF >

commands, see paragraph [0053]).

Referring to claim 47, the rationale for claim 43 is incorporated herein,

Bickmore et al., as modified above teaches the method of claim 43, wherein the text

message is an email message (Delorie: page 1, 3 and 5, lines 1-23, i.e. a sender writes

an e-mail text message based on underlying HTML commands such as those shown on

page 5).

Referring to claim 48, claim 48 recites all of the elements of claims 44 and 47

and therefore the rationale for the rejection of claims 44 and 47 are incorporated herein.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Bickmore et al. in view of Delorie, as applied to claim 44 above, and further in

view of Rosenblatt et al., U.S. Patent No. 6453294.

Referring to claim 45, the rationale for claim 44 is incorporated herein,

Bickmore et al., as modified above, teaches the method of enabling a sender to create a

multi-media message to a recipient of claim 44 having indicator indicating which

animated entity will deliver the respective portion of the multi-media text (paragraphs

[0009]-[0011], [0052], [0059]-[0064], i.e. the computer avatar is encapsulated into an

HTML file and transmitted/delivered to the recipient/reader computer as text document,

each character/animated entity in document are heard to speak their portion of the text

document according to the position in the text document of the link associated with their

avatar definition file), but does not specifically teach receiving in the text message

sender emoticons; and delivering the multi-media message using the emoticons

wherein each emoticon is associated with a most immediately preceding animated

entity indicator within the text message.

Rosenblatt et al. teaches this limitation (paragraph [0015], lines 7-11; paragraph

[0019], lines 1-6; paragraph [0022], i.e. a text window is provided that enables the user

to enter and edit text to be voiced by a selected virtual/animated representative/entity,

the text includes basic emotion cues that the selected virtual representative will evoke

while conveying the corresponding portion of the transmitted text, thus indicating that

the text message voiced by the selected entity includes sender emoticons wherein each

emoticon is associated with the text message being voiced and thus is associated with

a most immediately preceding animated entity indicator within the text message since

the immediately preceding animated entity indicator is understood to be indicating the

entity selected to voice the text).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method of Bickmore et al. to include the

teachings of Delorie and Rosenblatt et al. wherein the user is able to enter text to be

voiced by the selected virtual representative such that the text includes emoticons

representing facial expressions and emotions that the selected virtual representative will

evoke while conveying the corresponding portion of the transmitted text thereby

providing a highly flexible, programmable player that is modularized such that it may be

used and programmed inside a Web browser, used for reading e-mail files, or

embedded in applications for performing a variety of system interactions and wherein

the GUI is integrated in a client mail application such that the player GUI is invoked in

response to an e-mail message whereby the attachment of the e-mail message

contains a media file comprising a representation of the text to be voiced by a selected

virtual representative, along with the designated emotion cues wherein the player

generates an image of the virtual representative and modifies this image, based on the

emotion cues, as the text data is voiced (Rosenblatt et al.: paragraphs [0021]-[0022]).

Response to Arguments

Applicant's arguments with respect to new claims 43-48 have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ROBERTA PRENDERGAST whose telephone number

is (571)272-7647. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ulka Chauhan can be reached on (571) 272-7782. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberta Prendergast/
Examiner, Art Unit 2628
6/22/2009

/Peter-Anthony Pappas/
Primary Examiner, Art Unit 2628